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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARUN AHUJA, RAMADURAI VAIDYANATHAN, ANAND TATA, GRIGOR MARKARIAN, JOE PAN, and PETER TOMPSKINS

Appeal 2008-005067
Application 09/832,863¹
Technology Center 2400

Decided: February 12, 2010

Before JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, and ST. JOHN COURTENAY, III., and CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed April 12, 2001. The real party in interest is CITIBANK, N.A.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-23, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellants invented a system and method for providing a notification system, including a notification server which generates electronic messages to register customers upon their request or upon a host business request. (Spec. 41, Abstract.)

B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-23. Claims 1, 7, 8, 19, and 23 are independent claims. Claims 1 and 8 are illustrative:

1. A method for notifying a customer of at least one requested event comprising:

providing the customer with access to a notification system, including,

(i) determining a status of the customer as a member customer or a non-member customer of an institution providing the notification system,

(ii) generating access data for the customer, and

(iii) prompting the customer for the access data;

prompting the customer to select at least one requested event, wherein a member customer is provided with more event choices than a non-member customer;

storing the customer's at least one requested event selection in a first database;

prompting the customer to select at least one method of notification;

storing the customer's at least one method of notification selection in the first database;

prompting the customer to select at least one time for notification;

storing the customer's at least one time for notification selection in the first database;

receiving trigger data from at least a second database into the notification system that triggers the at least one requested event;

formulating a notification message that includes information about the at least one requested event; and

sending the notification message to the customer via the customer's at least one method of notification at the customer's at least one time for notification.

8. A system for notifying a customer of at least one requested event comprising:

means for generating a customer's financial notification preferences which include,

- (i) at least one requested event,
- (ii) a customer's notification method preferences, and
- (iii) a customer's time for notification preferences;

a database containing the customer's financial notification preferences;

a database containing financial information, wherein the financial information is collected from at least one internal source and at least one external source;

a notification message generator for comparing the at least one requested event with the financial information and

generating a notification message when the financial information matches the at least one requested event;

a notification gateway for sending the notification message to the customer according to the customer's notification method preferences and time for notification preferences; and

a database for generating a notification report at the customer's request, wherein the notification report includes at least data describing each notification message sent to the customer during a customer selected period of time.

C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Rajan	US 6,633,910 B1	Oct. 14, 2003
Langseth	US 6,694,316 B1	Feb. 17, 2004

D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 1-3, 5-17, and 19-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Langseth; and
- (2) Claims 4 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Langseth in view of Rajan.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Langseth

1. Langseth discloses that “[s]ubscribers may then sign up to receive output from one or more services from one or more of the channels of information.” (Col. 3, ll. 20-22.)
2. Langseth discloses that “affiliates may be associated with the personalized intelligence network to provide an avenue to reach potential subscribers. Affiliates may then selectively choose the subject matter of content to be delivered to their subscribers and that selection may be based on the business of the affiliate.” (Col. 3, ll. 39-43.)
3. Langseth discloses that “[i]f an affiliate-specific channel is created, that channel may be limited in availability to only the affiliate’s subscribers or may also be shared with other affiliate’s subscribers.” (Col. 27, ll. 32-35.)
4. Langseth discloses that “[i]n step 916, an affiliate may provide content to one or more of the channel databases.” (Col. 27, ll. 13-14.)
5. Langseth discloses that “if the affiliate is a bank, the data may comprise a complete transactional history of the subscriber with that bank so that the channel database is enriched with a broader base of data from which to generate reports.” (Col. 27, ll. 25-29.)
6. Langseth discloses that “[t]he data from step 916 may be loaded either into a pre-existing channel database with other information and/or transactional data at the PIN (step 920) or may be used to create a specific channel for that affiliate (step 918).” (Col. 27, ll. 29-32.)

III. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (internal citations omitted).

IV. ANALYSIS

Grouping of Claims

In the Brief, Appellants essentially argue claims 1-7 and 23² as a group (App. Br. 7-9). For claims 2-7 and 23, Appellants repeat the same argument made for claim 1. We will, therefore, treat claims 2-7, and 23 as standing or falling with claim 1.

Appellants argue claims 8-23 as a group (App. Br. 9-10). For claims 9-23, Appellants repeat the same argument made for claim 8. We will, therefore, treat claims 9-23 as standing or falling with claim 8. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Anticipation Rejection

We first consider the Examiner’s rejection of the claims under 35 U.S.C. § 102(e) as being anticipated by Langseth.

² Claim 23 includes argued limitations found in both claim 1 and claim 8.

Claims 1-7, and 23

Appellants contend that “[t]here is no status determination between member and non-member customers. Nor is there prompting of the customer to select an event, wherein member customers have more event choices than non-member customers.” (App. Br. 9.)

The Examiner found that “subscribers (member customer) are customers, however not all customers (non-member customers) are subscribers. Thus, [the] system has to determine the status of the customer.” (Ans. 5.)

Issue: Does Langseth describe “determining a status of the customer as a member customer or a non-member customer of an institution providing the notification system . . . wherein a member customer is provided with more event choices than a non-member customer?”

Here, the Examiner concludes that Langseth’s system *has to determine the status of the customer* (Ans. 5). We agree.

For example, Langseth discloses that the host system has members, e.g. subscribers, and a system for finding potential members for affiliates (FF 1-2). As noted *supra*, Claim 1 specifically requires “determining a status of the customer as a member customer or a non-member customer.” In other words, Claim 1 looks at the customer type of an institution providing the notification. In Langseth, both the host system and the affiliates provide output notification services (FF 1-2). Furthermore, Langseth discloses that if an affiliate-specific channel is created, that channel may be limited in availability to only the affiliate’s subscribers (FF

3). It goes to follow that if a channel is only made available to the affiliate's subscribers, there must be some inherent means for determining affiliate members from non-members. Furthermore, by limiting a channel to members only, in essence Langseth's system has given a member customer more event choices than a non-member customer.

Thus, Appellants have *not* persuaded us of error in the Examiner's conclusion of anticipation for representative claim 1. Therefore, we affirm the Examiner's § 102 rejection of independent claim 1 and of claims 2-7, and 23, which fall therewith.

Claims 8-22

Appellants contend that “[w]here Langseth is lacking is the disclosure of financial information from an internal source.” (App. Br. 9.)

The Examiner found that Langseth discloses that “if the affiliate is a bank, the data may comprise a complete transactional history of the subscriber with that bank so that the channel database is enriched with a broader base of data from which to generate reports.” (Ans. 31) (emphasis omitted).

Issue: Does Langseth describe “a database containing financial information, wherein the financial information is collected from at least one internal source and at least one external source”?

Here, the Examiner associates Langseth's transmitted bank affiliate data with the claimed financial information collected from at least one internal source. We agree.

We start by noting that we find the claimed “financial information” merely represents “non-functional descriptive material” that is not accorded patentable weight. *Non-functional* descriptive material refers to data content that does not exhibit a functional interrelationship with the substrate and does not affect the way the computing processes are performed. *See* MPEP § 2601.01. In a precedential decision, an expanded Board panel recently held that elements that do not affect the claimed process are non-functional material and are merely descriptive. *See Ex parte Nehls*, 88 USPQ2d 1883 (BPAI 2008).³ As such, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (*aff’d* 191 Fed. Appx. 959 (Fed. Cir. 2006)); Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d at 1339.

Although the claimed “financial information” is not given patentable weight, we find that Langseth nonetheless discloses financial information from an internal source. For example, we find that an “internal source” includes any source from within that particular notification system, either the affiliate system or the host system and “financial information” includes any information related to money or other liquid resources. Thus, the affiliate can be seen as an internal source and the affiliate’s transactional bank history can be seen as financial information. In Langseth, the affiliate provides financial data to a database that it itself can use, i.e., an internal

³ *See* <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>

source (FF 4-6). Langseth also discloses that the data may be loaded into a pre-existing database with other information and/or transactional data (FF 6). In other words, Langseth discloses that the affiliate may load financial data into a pre-existing database that the affiliate itself can access. Thus, we find unpersuasive Appellants' argument that Langseth's database lacks financial data from an internal source, given the above-noted findings.

As such, Appellants have *not* persuaded us of error in the Examiner's conclusion of anticipation for representative claim 8. Therefore, we affirm the Examiner's § 102 rejection of independent claim 8 and of claims 9-23, which fall therewith.

The Obviousness Rejection

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

Claims 4 and 18

Here, Appellants merely rely on the arguments presented *supra* (App. Br. 11), which we have already found unpersuasive.

Thus, Appellants have *not* persuaded us of error in the Examiner's conclusion of obviousness for claims 4 and 18. Therefore, we affirm the Examiner's § 103 rejection of claims 4 and 18.

V. CONCLUSION

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-18.

Thus, claims 1-18 are not patentable over the cited prior art.

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VI. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-23.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

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